

This Opinion is Not a  
Precedent of the TTAB

Mailed: July 19, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Chicago Cubs Baseball Club, LLC*

*v.*

*The CRATE Inc.*  
—

Opposition No. 91242453  
—

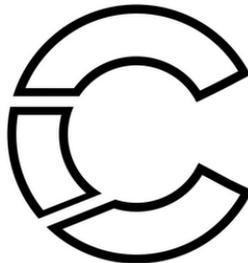
Mary L. Kevlin and Dasha Chestukhin of Cowan Liebowitz & Latman PC,  
for Chicago Cubs Baseball Club, LLC.

Jordan Greenberger of J. Greenberger PLLC,  
for The CRATE Inc.  
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Before Lykos, English and Lebow,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On September 29, 2017, The CRATE Inc. (“Applicant”) filed an application to register on the Principal Register the special form mark below



for “Hats; Headbands; Hoodies; Jackets; Shirts; Sweaters; Sweatpants” in International Class 25.<sup>1</sup> The description of the mark is as follows: “The mark consists of the letter ‘C’ split into three different parts.” Color is not claimed as a feature of the mark.

Chicago Cubs Baseball Club, LLC (“Opposer”) opposes registration of Applicant’s mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Opposer’s previously used and registered C and CUBS stylized/design marks in connection with baseball games and exhibition services and a variety of goods; false suggestion of a connection with Opposer under Section 2(a), 15 U.S.C. § 1152(a) of the Trademark Act; and likelihood of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).<sup>2</sup> In the Notice of Opposition, Opposer pleaded ownership of numerous registrations,<sup>3</sup> including the following:

Registration No. 2506407 for the mark displayed below on the Principal Register for “clothing, namely, caps, hats, headwear, headbands, shirts, t-shirts, baseball uniforms,

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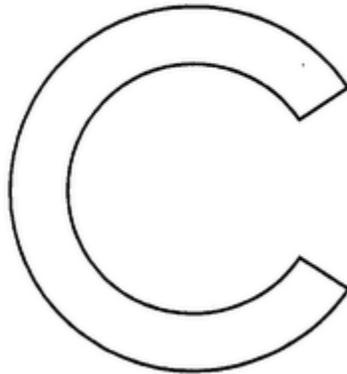
<sup>1</sup> Application Serial No. 87628141, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming February 28, 2016 as the date of first use anywhere and in commerce.

Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Portions of the record have been designated confidential. The citations to the record refer to the redacted, publicly available versions of each submission.

<sup>2</sup> Notice of Opposition, 1 TTABVUE *in passim*.

<sup>3</sup> Registration Nos. 869838; 1042652; 1183876; 1297664; 1536262; 1538033; 1538193; 1612016; 1916572; 2506407; 2667880; 3231135; 3320037; 3320038; 3320039; 3320040; 3326192; 3395907; 3403043; 3403046; 3545454 and 3854382. *See* Notice of Opposition ¶ 3; 1 TTABVUE 26-27.

jerseys, sweatshirts, sleepwear, jackets, cloth bibs, infantwear, footwear, socks” in International Class 25;<sup>4</sup>



Registration No. 1297664 for the mark displayed below on the Principal Register for “Baseball Caps” in International Class 25;<sup>5</sup>



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<sup>4</sup> Registered November 13, 2001, claiming April 16, 1957 as the date of first use anywhere and in commerce; renewed.

<sup>5</sup> Registered September 25, 1984, claiming December 1946 as the date of first use anywhere and in commerce; renewed.

Registration No. 1042652 for the mark displayed below on the Principal Register for goods in multiple classes, including “t-shirts, sweatshirts, pajamas, ponchos, jackets, pants, and robes” in International Class 25.<sup>6</sup>



Registration No. 1916572 for the mark displayed below on the Principal Register for “clothing, namely, shirts, caps, shorts, T-shirts, jackets, pants, visors, hats, uniforms, uniform jerseys, wind resistant jackets, short sets, sweatpants, sweatshirts,” in International Class 25.<sup>7</sup>



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<sup>6</sup> Registered July 6, 1976, claiming 1969 as the date of first use anywhere and in commerce; renewed.

<sup>7</sup> Registered September 5, 1995, claiming January 1994 as the date of first use anywhere and in commerce; renewed.

In its Answer, Applicant admitted that “certain of the identified marks are famous having been used in relation to the Chicago Cubs baseball team on various goods and services since prior to February 28, 2016.”<sup>8</sup> Otherwise, Applicant denied the salient allegations of the Notice of Opposition, and asserted various affirmative and putative defenses (i.e. amplifications of its denials).<sup>9</sup> Applicant also alleged that the Notice of Opposition failed to state a claim upon which relief may be granted, and that the complaint “fails to allege with specificity, and fails to provide Applicant with notice of, the basis of its alleged claims,”<sup>10</sup> defenses it maintained in its trial brief.

The case is fully briefed. Opposer, as plaintiff in this proceeding, bears the burden of establishing its entitlement to a statutory cause of action and claims by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

### **I. Applicant’s Affirmative Defenses**

As a threshold matter, we address Applicant’s affirmative defenses of failure of the Notice of Opposition to provide Applicant with notice of the basis of Opposer’s alleged claims and failure to state a claim. .

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<sup>8</sup> Answer ¶ 12, 7 TTABVUE 9. Applicant’s Answer was filed on November 27, 2018 with its Motion for Relief from Default Judgment, *Id.* at 8-10. Default judgment was vacated on January 7, 2019. 9 TTABVUE 1.

<sup>9</sup> Answer, “Affirmative Defenses” ¶¶ 1-5, 7 TTABVUE 10.

<sup>10</sup> Answer, Affirmative Defense ¶¶ 1-2, 7 TTABVUE 10. On February 27, 2019, the Board granted Opposer’s motion to strike Applicant’s affirmative defenses of unclean hands and laches. 14 TTABVUE 1.

With respect to failure to provide notice, Applicant argues that Opposer has taken a “shotgun approach” to its complaint by conflating over twenty trademarks into “their singular definition of the term ‘Opposer’s C Marks’...”<sup>11</sup> Applicant points to Opposer’s pleading of numerous common law and registered marks as set forth in Paragraph Nos. 2-3 of the Notice of Opposition, 1 TTABVUE 25.

We construe Applicant’s defense of “failure of the Notice of Opposition to provide Applicant with notice of the basis of Opposer’s alleged claims” as the equivalent of a motion for more definite statement under Fed. R. Civ. P. 12(e).<sup>12</sup> In pertinent part, Rule 12(e) provides:

A party may move for a more definite statement of a pleading to which a responsive pleading is allowed but which is so vague or ambiguous that the party cannot reasonably prepare a response. The motion must be made before filing a responsive pleading and must point out the defects complained of and the details desired. ...

Insofar as such a motion must be filed prior to filing an answer, Applicant’s assertion of this affirmative defense at trial is untimely. Accordingly, the affirmative defense is dismissed.

By contrast, Fed. R. Civ. P. 12(h)(2)(c) provides that the defense of failure to state a claim upon which relief can be granted may be raised at trial.<sup>13</sup> The better practice

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<sup>11</sup> Applicant’s Brief, p. 5; 64 TTABVUE 12.

<sup>12</sup> Except as otherwise provided in the Trademark Rules of Practice, inter partes proceedings before the Board are governed by the Federal Rules of Civil Procedure. Trademark Rule 2.116(a); 37 C.F.R. § 2.116(a).

<sup>13</sup> In pertinent part, the Rule provides, “If a pleading sets out a claim for relief that does not require a responsive pleading, an opposing party may assert at trial any defense to that claim.”

would have been to challenge the sufficiency of the Notice of Opposition by motion under Fed. R. Civ. P. 12(b)(6) prior to joinder. In any event, we consider this affirmative defense now.

A complaint must “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955, 1974 (2007); *see also Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937, 1949 (2009) (plausibility standard applies to all federal civil claims). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Id.* Applying this standard, we have reviewed the Notice of Opposition, and find that Opposer has adequately pleaded its asserted Section 2(d), Section 2(a), and dilution by blurring claims. Despite Opposer’s pleading of ownership in a myriad of common law and registered marks, the Notice of Opposition satisfies the plausibility standard. In particular, in Paragraph Nos. 8 and 9 of the Notice of Opposition, Opposer highlights three of “Letter C” marks unaccompanied by additional wording such as CUBS or designs.<sup>14</sup>

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<sup>14</sup> 1 TTABVUE 27.

8. Applicant's Mark consists of a prominent stylized "C" that is nearly identical to certain of Opposer's C Marks. This similarity is shown below:

Applicant's Mark



Three of Opposer's C Marks



9. The goods covered by the Application are identical to and/or closely related to the goods offered and services rendered in connection with Opposer's C Marks.

In view thereof, Applicant's affirmative defense of failure to state a claim is dismissed.

## **II. The Record**

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.

### **A. Opposer's Evidence**

Testimony Declaration of Kelly King, Manager of Graphics for Opposer, dated May 13, 2021 ("King Decl."), and accompanying Exhibits A-T (41-43 TTABVUE).

Testimony Declaration of Denis Nolan, Senior Vice President, Global Consumer Products of MLB Advanced Media, L.P. ("MLBAM"), dated May 7, 2021 ("Nolan Decl."), and accompanying Exhibits A-C (38-40 TTABVUE).

Testimony Declaration of Sarah Horvitz, Senior Vice President and Head Business and Technology Counsel Manager of Graphics of MLBAM, dated May 17, 2021 ("Horvitz Decl."), and accompanying Exhibits A-L (44-50 TTABVUE).

Testimony Declaration of Richard Claverie, paralegal of Cowan, Liebowitz & Latman, P.C., dated May 12, 2021 ("Claverie Decl."), and accompanying Exhibits A-H (37

TTABVUE).

Opposer's First Notice of Reliance dated May 11, 2021, consisting of printouts from the USPTO's Trademark Status and Document Retrieval ("TSDR") database of Opposer's pleaded registrations (32 TTABVUE).

Opposer's Second Notice of Reliance dated May 11, 2021 and attached Exhibits A-G, consisting of Opposer's First Set of Requests for Admission Nos. 1-20 and Applicant's responses thereto, and Applicant's responses to Opposer's Revised First Set of Interrogatories Nos. 1-2, 6-7, 9-12 and 14-16, and Requests for Production Nos. 5, 9-12, 17 and 20-21 (34 TTABVUE).

Opposer's Third Notice of Reliance dated May 12, 2021 and attached Exhibits A-B consisting of news articles and book excerpts (35 TTABVUE).

Opposer's Fourth Notice of Reliance dated May 12, 2021 and attached Exhibits A-D consisting of Internet news articles, social media posts, and screenshots of Applicant's website (36 TTABVUE).

## **B. Applicant's Evidence**

Testimony Declaration of Terrill Kirk, co-founder, owner, and Secretary of Applicant, dated July 12, 2021 ("Kirk Decl."), and accompanying Exhibit A (52-53 TTABVUE).

Applicant's Amended Notice of Reliance,<sup>15</sup> dated October 26, 2021, and accompanying Exhibits 1-5 consisting of, an online news article about Applicant, a screenshot of a Major League Baseball website, a Google Street View screenshot for the address of Applicant's physical retail store, and Applicant's Responses & Objections to Opposer's Revised First Set of Interrogatories Nos. 5, 8, 13 and 16 (59 TTABVUE).

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<sup>15</sup> On October 12, 2021, the Board granted Opposer's motion to strike portions of Applicant's originally filed notice of reliance, and gave Applicant time to file an amended notice of reliance. 58 TTABVUE.

### **III. The Parties**

#### **A. Opposer**

Opposer owns the Chicago Cubs, a Major League Baseball club.<sup>16</sup> The Chicago Cubs were “founded in 1870 as one of the charter members of the National League in 1876, and is the oldest, continuous professional sports team in the United States still playing in its original city.”<sup>17</sup> “Since 1902, the Club has been commonly known and referred to around the world as the ‘CUBS.’”<sup>18</sup>

Kelly King, Manager of Graphics for Opposer, testified that “[t]he Cubs are one of the most famous Major League Baseball clubs, have made eleven World Series championship series appearances and have won three World Series championship titles, including most recently in 2016 when the Cubs won their first World Series title since 1908.”<sup>19</sup> “As more than a century passed between the Cubs’ World Series victories, the legend of a curse surrounding the Cubs grew, and the public’s interest in the Cubs intensified as sports fans wondered whether they would ever win another World Series title.”<sup>20</sup> “Cubs’ fans nevertheless remained steadfast in their loyalty to their team.”<sup>21</sup> “The Cubs made numerous postseason appearances, including in 2003, 2007, 2008 and 2015.”<sup>22</sup> “The Cubs’ long-awaited World Series victory in 2016 over

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<sup>16</sup> King Decl. ¶ 1; 41 TTABVUE 6.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> King Decl. ¶ 5, 41 TTABVUE 6.

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

the Cleveland Indians in an exciting seven-game series generated significant attention from fans, the press, the media and the public as finally breaking the curse supposedly haunting the Cubs.”<sup>23</sup> She further testified that “[t]he Cubs have long attracted, and are known for possessing, an unusually dedicated and loyal fan base that reaches across the country.”<sup>24</sup>

Ms. King testified further that for over 110 years “Opposer and its predecessors, and their affiliated and related entities, licensees and/or sponsors, have used names and marks that comprise or contain a stylized, squared-edged letter C, alone or with other word, letter and/or design elements, including, without limitation, the term ‘CUBS,’ the geographic designation ‘CHICAGO’ and/or the design or depiction of a bear or bear cub (collectively, ‘Opposer’s C Marks’ or the ‘C Marks’), to identify the Club, its baseball game and exhibition services, and a wide variety of goods and services, including, but not limited to, apparel.” “Examples of Opposer’s C Marks, some of which date back as far as 1908, are shown below:



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<sup>23</sup> *Id.*

<sup>24</sup> King Decl. ¶ 21, 41 TTABVUE 23 and Ex. M (“2001 JOURNAL OF CONSUMER MARKETING article entitled “Holy cow! Wait ‘til next year! A closer look at the brand loyalty of Chicago Cubs baseball fans”), 42 TTABVUE 268-285.

A common element in these C Marks is the square-edged shape of the ends of the letter ‘C,’ whether displayed in a solid or outlined format.”<sup>25</sup> Opposer’s “Primary Logo” since 1979 is reprinted below:<sup>26</sup>



One of “Opposer’s C Marks” has been displayed alone on the Cubs’ headwear since 1957 (“Headwear Logo”):<sup>27</sup>



Opposer’s C Marks are licensed through MLBAM for use on apparel, including shirts, jackets, sweatshirts, sweatpants, hoodies, sweaters, hats, headbands.<sup>28</sup> “These uses also frequently involve displaying Opposer’s C Marks in different formats, including as appearing in the Headwear Logo or the Primary Logo, and/or with a variety of fashion-forward and visually interesting colorways, as well as combining Opposer’s C Marks with various other words, phrases and/or designs in order to offer a wide selection of different concepts to a fan base constantly searching for new ways

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<sup>25</sup> King Decl. ¶ 7, 41 TTABVUE 7. *See also* Horvitz Decl. ¶ 5, 44 TTABVUE 6-7.

<sup>26</sup> King Decl. ¶ 8, 41 TTABVUE 7.

<sup>27</sup> *Id.*

<sup>28</sup> King Decl. ¶ 9, 41 TTABVUE 8.

to display their allegiance to their favorite team.”<sup>29</sup> Licensees of Opposer’s “C Marks” in connection with apparel include Nike, Keds, Ralph Lauren, Tommy Bahama, Supreme, Vineyard Vines, Wilson, Dooney & Bourke, Majestic, 5th & Ocean/New Era Apparel, Fanatics, Mitchell & Ness, KITH, Outerstuff, UNTUCKit and Stance Socks.<sup>30</sup> Licensed merchandise bearing Opposer’s “C Marks” is “widely available through a broad spectrum of channels of trade, including the official Major League Baseball website at [www.mlbshop.com](http://www.mlbshop.com) (the “MLB Shop Website”), the websites of MLB Clubs, in-stadium concessionaries, The Cubs Store, catalogs and many other retail locations (both online and brick-and-mortar stores), including without limitation, such national chains as Dick’s Sporting Goods, Target, Bed Bath & Beyond, American Eagle, Modell’s, Walmart, Kmart, Party City, MajesticAthletic.com, Fanatics.com, Lids.com, FansEdge.com, and countless other retailers, which collectively have thousands of store locations nationwide and/or a broad online presence.”<sup>31</sup> In addition to television, radio and print media outlets, Opposer also “promotes Opposer’s C Marks extensively on social media platforms such as Facebook, Twitter, Instagram, Snapchat and TikTok” as well as the Chicago Cubs’ official website located at [www.mlb.com/cubs](http://www.mlb.com/cubs).<sup>32</sup>

## **B. Applicant**

Applicant is a clothing company that was founded in 2014 in Far Rockaway

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<sup>29</sup> King Decl. ¶ 9, 41 TTABVUE 8. *See also* Nolan Decl. ¶ 6, 39 TTABVUE 7.

<sup>30</sup> Nolan Decl. ¶ 6, 39 TTABVUE 7.

<sup>31</sup> Nolan Decl. ¶ 7, 39 TTABVUE 8.

<sup>32</sup> King Decl. ¶¶ 13, 15, and 16, 41 TTABVUE 8

Queens, New York, “as a luxury leisure brand designed for clientele that appreciates and identifies with hip-hop culture.”<sup>33</sup> Applicant’s clothing designs “often refer to popular culture, such as sports, politics, and local news. ... Icons such as Kanye West, J. Cole, Carmelo Anthony, and Wiz Khalifa have been seen wearing [Applicant’s] apparel.”<sup>34</sup> Applicant “primarily sells streetwear apparel, including sweatshirts, t-shirts, hats, and sweatpants” and “does not manufacture or sell sports equipment.”<sup>35</sup> However, “some of the apparel that [Applicant] sells might be used by consumers for athletic purposes (e.g., t-shirts, sweatshirts, hats), but [Applicant] does not specifically target the athletic goods or athletic apparel market.”<sup>36</sup> Applicant’s clothing items “range from approximately \$25.00 to \$300.00 based on the type of product and their exclusivity (retail prices for hats are \$40-\$65; for headbands, \$25-\$30; for hoodies, \$150-\$300; for jackets, \$250-\$300; for shirts, \$40-\$150; for sweaters, \$75-\$150; and for sweatpants, \$75-\$150).”<sup>37</sup>

Applicant’s primary trade channels are its brick-and-mortar retail store located in Far Rockaway, New York and its direct-to-consumer online store, [www.thecrateny.com](http://www.thecrateny.com).<sup>38</sup> Applicant also promotes and markets its clothing line via the social media platforms Instagram, Twitter, and Facebook.<sup>39</sup>

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<sup>33</sup> Kirk Decl. ¶ 2, 52 TTABVUE 3.

<sup>34</sup> Kirk Decl. ¶ 2, 52 TTABVUE 3.

<sup>35</sup> Kirk Decl. ¶ 4, 52 TTABVUE 4.

<sup>36</sup> *Id.*

<sup>37</sup> Kirk Decl. ¶ 5, 52 TTABVUE 4.

<sup>38</sup> Kirk Decl. ¶ 7, 52 TTABVUE 4.

<sup>39</sup> Kirk Decl. ¶ 11, 52 TTABVUE 5.

Mr. Kirk, Applicant's co-founder, owner, and Secretary, testified that he devised "the conceptual idea for the subject 'C' mark, namely the letter C divided in three sections" as Applicant's logo with the assistance of a third-party graphic designer.<sup>40</sup> Applicant selected the mark "because (a) our name is 'The Crate, Inc.,' and the dominant work in the name ('crate') begins with the letter C; and (b) as designed and used, the mark is aesthetically pleasing... ." <sup>41</sup> Applicant "sometimes (but not always) uses the subject 'C' mark with a color combination of red, white and blue" with the "intent ... to represent the flag of the United States of America, where all of the [Applicant's] products are made."<sup>42</sup>

#### **IV. Entitlement to a Statutory Cause of Action**

An opposer in an inter partes case must prove entitlement to a statutory cause of action. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). Section 13 of the Trademark Act, 15 U.S.C. § 1063(a) states:

Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.

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<sup>40</sup> Kirk Decl. ¶ 15, 52 TTABVUE 6.

<sup>41</sup> Kirk Decl. ¶ 16, 52 TTABVUE 6.

<sup>42</sup> Kirk Decl. ¶ 18, 52 TTABVUE 6.

To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, Opposer must demonstrate (1) that its claims are within the zone of interests protected by the statute (i.e., has a “real interest” in the outcome of the proceeding) and (2) damage proximately caused by registration (i.e., a reasonable basis for its belief in damage). See *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020); *Empresa*, 111 USPQ2d 1162; see also *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

Opposer has demonstrated through the TSDR printouts made of record that it is the owner of its pleaded registrations, and that the registrations are valid and subsisting.<sup>43</sup> In addition, as noted above, Opposer presented testimony and documentary evidence of an extensive licensing program of its marks in connection with apparel.<sup>44</sup> Although designated confidential, the record shows that between 2013 – 2020, Opposer’s merchandise licensing program for apparel bearing its “C Marks” generated an enormous amount of revenue.<sup>45</sup>

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<sup>43</sup> Opposer’s Notice of Reliance, Ex. A, 32 TTABVUE 9-157.

<sup>44</sup> Horvitz Decl. ¶ 5, Ex. A, 44 TTABVUE 6-7, 17-105; King Decl. ¶¶ 7-8, 41 TTABVUE 7-8).

<sup>45</sup> Nolan Decl. ¶ 5, 40 TTABVUE (confidential).

Based on this evidence, we find Opposer has a reasonable belief of damage that is proximately caused by Applicant's applied-for mark. The opposition therefore falls within the zone of Opposer's interests as protected by Section 13 of the Trademark Act.

Opposer has clearly established its entitlement to bring a Section 2(d) claim that is plausible. *See Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Once a plaintiff has shown entitlement to a statutory cause of action on one ground, it has the right to assert any other ground in an opposition which in this case includes Opposer's dilution and false suggestion claims. *See, e.g., Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment).

#### **V. Section 2(d) Claim**

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We consider each element of this claim, priority and likelihood of confusion, below.

#### **A. Priority**

Because, as noted above, Opposer properly made of record its valid and subsisting pleaded registrations and Applicant did not counterclaim to cancel them, priority is

not at issue for the marks and the goods and services identified in each individual registration. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

### **B. Likelihood of Confusion**

Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences

in the essential characteristics of the goods and differences in the marks.”). These factors, and the other *DuPont* factors argued by each party, are discussed below.

We will focus the likelihood of confusion analysis on Opposer’s Registration No. 2506407, which is most similar to Applicant’s mark. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we find a likelihood of confusion as to that mark and those goods, we need not find it as to Opposer’s other registered marks; conversely, if we do not find a likelihood of confusion as to Opposer’s C mark for “clothing, namely, caps, hats, headwear, headbands, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, sleepwear, jackets, cloth bibs, infantwear, footwear, socks” in International Class 25, we would not find it as to Opposer’s other registered marks for the goods identified therein.

**1. The Similarity or Dissimilarity of the Goods and the Established, Likely-to-Continue Channels of Trade and Classes of Consumers**

We first compare the goods as they are identified in the involved application and Opposer’s registration, the second *DuPont* factor. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Applicant acknowledges that both parties sell some of the same clothing items such as athletic hats and shirts. Nonetheless, it contends that differences in style render these items distinct. Applicant specializes in a luxury leisure brand designed

for what it describes as a niche clientele that identifies with hip-hop culture,<sup>46</sup> whereas it contends that Opposer's licensed apparel serves as collateral merchandise to its primary service (professional baseball) and is intended for Chicago Cub baseball fans. Applicant also asserts that athletic wear such as baseball hats have now become part of the broader fashion world and are not limited to baseball enthusiasts or participants.

When analyzing the second *DuPont* factor, because we must focus on the identification of goods set forth in the application and registration, Applicant's arguments are unavailing. *See Stone Lion*, 110 USPQ2d at 1162. The Board may not read limitations into Opposer's unrestricted registration or Applicant's application based on extrinsic evidence. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation here, and nothing in the inherent nature of SquirtCo's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The board, thus, improperly read limitations into the registration."). Both the application and registration include hats, headbands, jackets, and shirts, without any qualifying language regarding style, gender or age. Because these apparel items are unrestricted, they necessarily encompass all types, including lines designed for devotees of hip hop culture or Chicago Cubs baseball fans. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). Thus, on

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<sup>46</sup> Kirk Decl., ¶ 2, 52 TTABVUE 3.

their face, Applicant's and Opposer's goods are in-part identical.<sup>47</sup>

This brings us to the third *DuPont* factor, the established, likely-to-continue channels of trade and classes of consumers as delineated in the identifications. *See Detroit Athletic Co.*, 128 USPQ2d at 1051. Applicant argues that the trade channels do not overlap because Applicant only sells its clothing line at its brick-and-mortar retail store located in Queens, New York and via its direct-to-consumer website.<sup>48</sup> Mr. Kirk, Applicant's co-founder, further testified that these are likely to remain Applicant's primary trade channels.<sup>49</sup> By contrast, it argues, Opposer primarily sells its licensed Chicago Cubs themed collateral merchandise in the narrow trade channels of baseball stadiums, baseball team branded stores in the Chicago area, and the MLB website. Applicant acknowledges that some of its customers may be sports fans, major league baseball fans or fans of the Chicago Cubs, but asserts that the record shows that Applicant does not target such consumers, nor does it have any future intentions of doing so.<sup>50</sup>

Applicant's contentions are misplaced. Because the goods are in-part identical and unrestricted as to trade channels, we must presume that these particular goods travel

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<sup>47</sup> "[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application." *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)). *See also In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

<sup>48</sup> Kirk Decl., ¶ 7, 52 TTABVUE 4.

<sup>49</sup> *Id.*

<sup>50</sup> Kirk Decl., ¶ 13, 52 TTABVUE 5.

in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Such ordinary trade channels include brick-and-mortar retail stores featuring clothing and headwear. In addition, it is presumed that Applicant's and Opposer's identical apparel items are offered to all normal potential consumers, which would include not only hip hop music aficionados and sports enthusiasts but all members of the general public. *Octocom*, 16 USPQ2d at 1787; *cf. In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1749-50 (Fed. Cir. 2017) (goods and channels of trade held to be identical or closely related notwithstanding language in applicant's identifications that its goods were "associated with William Adams, professionally known as 'will.i.am'"). Thus, while purchasers of Applicant's clothing line may be motivated to buy the identified goods to demonstrate their affinity for hip hop music, while consumers of Opposer's apparel are seeking to demonstrate their allegiance to the Chicago Cubs, given the lack of restrictions in the application and registration, Applicant's argument necessarily fails.

For these reasons, the second and third *DuPont* factors weigh strongly in favor of

finding a likelihood of confusion.

## 2. Purchasing Conditions

We turn now to the fourth *DuPont* factor, the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant contends, without evidentiary support, that consumers of Opposer's goods, which are collateral items to Opposer's baseball club services, are likely to exercise a higher degree of care when making purchasing decisions. Applicant theorizes that the fierce loyalty of the Chicago Cubs fan base mitigates against confusion because

[s]ports fans do not just buy any emblem, or any shirt or hat. Sports fans buy their team's emblem, their team's shirt, their team's hat. Simply put, if their team's brand is not on the product, the sports fan will not buy it. The loyalty of the Cubs' fans mitigates the risk of confusion. Even when the cost of the goods are relatively modest, ordinary individuals can be quite knowledgeable about a subject in which they have developed a strong economic or avocational interest.<sup>51</sup>

Applicant also points to the fact that Chicago Cubs fans travel outside of Chicago to away-games and purchase online game subscriptions as reflecting an elevated level of sophistication on their part. This, coupled with Applicant's fashion-conscious

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<sup>51</sup> Applicant's Brief, p. 20; 64 TTABVUE 27.

consumers who also engage in discriminating purchasing decisions when selecting luxury brand hip-hop attire, make confusion unlikely. Applicant's apparel line has a price range from approximately \$25.00 to \$300.00 (retail prices for hats are \$40-\$65; for headbands, \$25-\$30; for hoodies, \$150-\$300; for jackets, \$250-\$300; for shirts, \$40-\$150; for sweaters, \$75-\$150; and for sweatpants, \$75-\$150).<sup>52</sup>

Applicant's arguments are misplaced. As identified, the parties' respective goods are not limited in any way as to purchasers, conditions of sale, quality or price. It therefore must be assumed that both parties' hats, headbands, jackets, and shirts are available to all consumers, and not just Chicago Cubs fans or hip hop culture fashionistas. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000) (must focus on identifications, regardless of any actual marketplace evidence of "the particular channels of trade, or the class of purchasers to which sales of the goods or services are directed"); *Bay State Brewing*, 117 USPQ2d at 1960; *see also Stone Lion*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class").

In addition, the identifications in the application and Opposer's registration lack a specified price point. We must assume that the products are sold at all prices ranges and to all types of buyers and overlap to include both the discriminating purchaser seeking high-end apparel as well as the ordinary bargain hunter. Ordinary consumers of headwear and clothing are likely to exercise only ordinary care, and given the lack of price restrictions in the identifications, they may even buy

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<sup>52</sup> Kirk Decl. ¶ 5, 52 TTABVUE 4.

inexpensive items on impulse. *See Recot*, 54 USPQ2d at 1899 (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”). The conditions of sale therefore favor finding a likelihood of confusion.

### **3. The Similarity or Dissimilarity of the Marks**

This *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed Cir. 2005) (quoting *DuPont*, 177 USPQ at 577). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). Further, the marks “must be considered ... in light of the fallibility of memory ...” *In re St. Helena Hosp.*, 774 F.3d 747, 113

USPQ2d 1082, 1085 (Fed. Cir. 2014) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). “Similarity is not a binary factor but is a matter of degree.” *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

When the marks at issue are both design marks, as is the case here, the similarity of the marks is typically decided primarily on the basis of visual similarity. *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). The marks may not be viewed side-by-side in the marketplace and a purchaser’s recollection of design marks is often of a general, rather than specific, in nature; thus the marks may be confusingly similar despite differences between them. *See, e.g., In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman, used in connection with distributorship services in the field of health and beauty aids, and mark consisting of a design featuring silhouettes of a man and woman, used in connection with skin cream, likely to cause confusion); *In re Steury Corp.*, 189 USPQ 353 (TTAB 1975) (holding mark consisting of three generally horizontal bars, for, *inter alia*, boats, campers, and travel trailers, and mark consisting of two generally horizontal bars, for, *inter alia*, boats, campers, and travel trailers, likely to cause confusion); *Matsushita Elec. Indus. Co.*

*v. Sanders Assocs., Inc.*, 177 USPQ 720 (TTAB 1973) (holding mark consisting of a triangular arrow design within a square border, for various items of electrical and electronic equipment, and mark consisting of a triangular arrow design, for various items of electrical and electronic equipment, likely to cause confusion).

Applicant argues that the marks are visually distinct because its stylized letter C mark is divided into three outlined portions whereas Opposer's letter C mark appears in a continuous line. Applicant speculates that the fierce loyalty of the Chicago Cubs fanbase means that such consumers would readily know that Applicant's mark is distinct from any of Opposer's marks. "Just like fans of the Chicago Cubs would recognize that the Cleveland Indian's usage of the colors red, white and blue and of the letter 'C' is distinct from the Cubs' usage of those colors and the letter 'C', the same fans should recognize that the usage of a trisected letter 'C' with various color combinations and other settings is a distinct mark unaffiliated with their baseball team."<sup>53</sup>

We disagree. Consumers do not focus on minutia but rather overall impressions. *See, e.g., In re John Scarne Games, Inc.*, 120 USPQ 315, 315-16 (TTAB 1959) ("Purchasers of game boards do not engage in trademark syllable counting — they are governed by general impressions made by appearance or sound, or both."). Each mark is comprised of a single element, a stylized letter "C," thereby making the marks identical in pronunciation, connotation, and commercial impression. In term of visual similarities, both marks are similar in size and aperture with squared-edges. While

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<sup>53</sup> Applicant's Brief, p. 2, 64 TTABVUE 9.

Applicant's mark is divided into three portions, overall the visual similarities remain striking.

Furthermore, Applicant's arguments regarding its and Opposer's purported usage of each respective mark in a red, white, and blue color scheme to evoke the U.S. flag are unavailing. Neither mark claims color as a feature, meaning that the marks could be used in the same color or color scheme. *See* Trademark Rule 2.52(b)(1), 37 C.F.R. § 2.52(b)(1) ("If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark."). While Applicant presented testimony that it frequently uses its mark displayed in the colors red, white, and blue, our analysis is based on the marks as depicted in the application and registration without regard to how the marks appear in actual use. *Cf. In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information."). Thus, our comparison involves a determination of whether Applicant's mark as it appears on the drawing page is similar in appearance, sound, connotation and commercial impression to Opposer's registered mark as it appears in the registration's drawing, and nothing more.

Although the marks have slight visual differences, when we compare them in their entireties, we find that overall they are highly similar in appearance, sound,

connotation and overall commercial impression. Furthermore, the in-part identity of Applicant's and Opposer's goods reduces the degree of similarity between the marks necessary to find a likelihood of confusion. *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Max Capital*, 93 USPQ2d at 1248. Accordingly, this *DuPont* factor also weighs strongly in favor of finding a likelihood of confusion.

#### **4. Strength of Opposer's Mark**

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) ("The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

**a. Inherent or Conceptual Strength**

Opposer's mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *Tea Bd. of India*, 80 USPQ2d at 1889. Opposer's registration is "prima facie evidence of the validity of the registered mark ..." Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See also Tea Bd. of India*, 80 USPQ2d at 1899. Third-party registrations alone may be relevant, in the manner of dictionary definitions, "to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted). *See also See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015). We have no evidence that the letter C has a particular significance in the clothing industry. Nor do we have evidence of third-party registrations of marks comprised solely of the letter C for the same or similar goods that might demonstrate the inherent weakness of this component as a source identifier. Thus, on this record, Opposer's registered mark for the identified goods is inherently and conceptually strong.

**b. Commercial Strength or Fame**

Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. *Id.* The fifth *DuPont* factor of fame if it exists,

plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs.*, 101 USPQ2d at 1720 (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

The commercial strength or fame of a mark is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). Rather, likelihood of confusion fame “varies along a spectrum from very strong to very weak.” *See Palm Bay*, 73 USPQ2d at 1694 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)). Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.*

Fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *See Palm Bay*, 73 USPQ2d at 1692. Unlike dilution, “the proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the

class of customers and potential customers of a product or service, and not the general public.” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the marks; and the general reputation of the goods. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength).

Opposer argues that Applicant has admitted that “at least some of Opposer’s C Marks, are famous.”<sup>54</sup> However, upon review of Applicant’s responses to Opposer’s Requests for Admissions shown below, we disagree that such admission is probative due to ambiguous wording:

**REQUEST NO. 8:**

- (a) Admit that Opposer’s C Marks are famous.
- (b) Admit that Opposer’s C Marks were famous prior to February 28, 2016, Applicant’s claimed first use date for Applicant’s Mark.
- (c) Admit that Opposer’s C Marks were famous prior to September 29, 2017, the filing date of the Application for Applicant’s Mark.

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<sup>54</sup> Opposer’s Brief, p. 27, 60 TTABVUE 34; Opposer Second Notice of Reliance Ex. B, 34 TTABVUE 127-28 (Applicant’s Response to Opposer’s Request for Admission No. 8).

(d) Admit that Opposer's C Marks were famous prior to any use by Applicant of Applicant's Mark in the United States or in commerce in connection with any goods or services.

**RESPONSE TO REQUEST NO. 8:**

Applicant objects because Opposer's definition of "Opposer's C Marks" is vague and overly broad. Subject to that objection, Applicant admits that certain of the marks identified in the notice of opposition are and were famous at relevant times and otherwise lacks knowledge or information.

In the request, "Opposer's C Marks" are not specifically delineated. The same holds true as to Applicant's admission in its Answer, Paragraph No. 12 that some of Opposer's marks are famous. As such, we cannot determine whether Applicant's partial admission pertains to Opposer's registered C mark that we are focusing on in our likelihood of confusion analysis.

Opposer did submit other relevant evidence of commercial strength or fame. The evidence however is problematic for analyzing Opposer's Section 2(d) claim because the testimony and evidence collectively refers to Opposer's "C Marks" as famous without directly linking indicia such as advertising expenditures or revenue to a particular mark and goods. *See Weider Publ'ns*, 109 USPQ2d at 1355 n. 20 and n. 21 (likelihood of confusion fame is limited to particular the goods and services). Thus, on this particular record, we deem the fifth *DuPont* factor neutral as it pertains to Opposer's mark and goods set forth in Registration No. 2506407.

**c. The Number and Nature of Similar Marks in Use on Similar Goods**

We will now consider the number and nature of similar marks in use on similar goods, the sixth *DuPont* factor. In an inter partes proceeding "[t]he purpose of [an

applicant] introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay*, 73 USPQ2d at 1694). See also *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay*, 73 USPQ2d at 1693.

Applicant postulates, without any factual support, that “the Chicago Cubs do not have a monopoly on using the letter ‘C’ for clothing.”<sup>55</sup> The record, however, is devoid of third-party use of the letter C as a trademark in connection with clothing. The only purported evidence of third-party use Applicant submitted is the state flag of Colorado which displays a red letter C in a purportedly similar font to Opposer’s mark. Aside from the fact that a state flag is not the equivalent of a trademark, there is no evidence that this emblem is used in connection with similar goods. See *Omaha Steaks*, 128 USPQ2d at 1694 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case”).

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<sup>55</sup> Applicant’s Brief, p. 15; 64 TTABVUE 22.

Applicant also points to the common usage of the color scheme red, white and blue in the U.S. flag as well as the logos and uniforms of various professional baseball teams such as the Cleveland Indians, the Boston Red Socks, the Minnesota Twins, the Texas Rangers, the Toronto Blue Jays, the Washington Nationals and the logo for Major League Baseball (MLB) as examples of third-party use diminishing the strength of Opposer's C mark. In connection therewith, Applicant requests that the Board take judicial notice of the usage of the colors red, white, and blue in the American flag, and that the colors red, white and blue are a commonly used color scheme "in various items ... including the logos and/or uniforms of various other professional baseball teams."<sup>56</sup> We grant Applicant's request to take judicial notice of the usage of the colors red, white, and blue in the American flag. *See* Fed. R. Evid. 201(b)(2) ("The court may judicially notice a fact that is not subject to reasonable dispute because it can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned."<sup>57</sup> However, we deny Applicant's request that the Board take judicial notice that the colors red, white and blue are a commonly used color scheme in the logos and uniforms of various other professional baseball teams. *See* Fed. R. Evid. 201(b)(2). *See, e.g., In re Wada*, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998) (Board did not take judicial notice that there exist "thousands" of registered marks incorporating the term NEW YORK for goods and services that do

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<sup>56</sup> Applicant's Brief, p. 27, 64 TTABVUE 27 and Applicant's Notice of Reliance Cover Sheet ¶ 3, 51 TTABVUE 3.

<sup>57</sup> Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a), provides in relevant part that "[u]nless the parties otherwise stipulate, the rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence...".

not originate there), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).<sup>58</sup> To properly make evidence of third-party trademark use of record for the purpose of showing weakness of a mark, Applicant had several options, including submitting under notice of reliance website printouts of such usage. *See* Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). However, as noted above, neither Applicant's nor Opposer's mark claims color as a feature making any arguments or evidence in this regard irrelevant.

On the record before us, we have no evidence that consumers have been exposed to so many letter C trademarks for use in connection with apparel that "customers 'have been educated to distinguish between different [such] marks on the bases of minute distinctions.'"<sup>59</sup> *Palm Bay*, 73 USPQ2d at 1694. We therefore deem the *DuPont* factor regarding the number and nature of similar marks in use on similar goods neutral.

In summary, Opposer's registered mark for the identified goods is conceptually strong. On this record, Applicant has not shown that the mark has been weakened by third-party registrations or uses of similar marks by competitors in the industry offering the same or similar goods. We therefore accord Opposer's mark "the normal scope of protection to which inherently distinctive marks are entitled." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

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<sup>58</sup> We need not take judicial notice of the image of the MLB logo since the image is part of the record.

<sup>59</sup> We note, by contrast, that in *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record, see 115 USPQ2d at 1672 n. 1, and in *Jack Wolfskin*, there were at least fourteen, 116 USPQ2d at 1136 n.2.

## 5. Actual Confusion

This eighth *DuPont* factor requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020). Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade could be telling. In this regard, we consider all of the evidence of record that may be relevant to the eighth *DuPont* factor. The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-07 (TTAB 1988); *Central Soya Co. v. North Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

Applicant argues that the parties' concurrent use of their respective marks for six (6) years without any known instance of actual confusion creates a strong inference that confusion is unlikely.<sup>60</sup> Opposer counters that the absence of actual confusion evidence can be explained by Applicant's relatively modest sales.<sup>61</sup> Opposer also cites Applicant's lack of advertising expenditures in 2016 to 2018<sup>62</sup> and limited trade channels -- one retail store in Far Rockaway, New York and Applicant's direct-to-consumer website.<sup>63</sup> Applicant in turn criticizes Opposer for "bunting" on this *DuPont* factor by characterizing it as "neutral," and rejects the notion that its sales figures are modest.

As noted above, our analysis as to the second and third *DuPont* factors, discussing the similarity or dissimilarity of the goods and channels of trade, is based on the identifications as set forth in the application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162. As such, when determining those factors, we may not consider evidence of how Applicant and Opposer are actually selling their goods in the marketplace. *Id.* As stated, the eighth *DuPont* factor, by contrast, requires us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020) (emphasis in original). *See also Jim Beam Brands Co. v. JL Beverage Company LLC*, 2021 USPQ2d

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<sup>60</sup> Kirk Decl., ¶¶ 35-36, 52 TTABVUE 10.

<sup>61</sup> Opposer's Second Notice of Reliance, Ex. G, 34 TTABVUE (confidential) (Applicant's second amended Response to Opposer's Interrogatory No. 7(d)).

<sup>62</sup> Kirk Decl. ¶ 12, 52 TTABVUE 5.

<sup>63</sup> Opp. Second Notice of Reliance, Ex. G, 34 TTABVUE (confidential) (Applicant's second amended Response to Interrogatory No. 7(d)); Kirk Decl. ¶¶ 7, 12, 14, 52 TTABVUE 4-6.

885, (TTAB 2021); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*17 (TTAB 2020).

The record does not include a breakdown of sales figures under Opposer's registered mark for the goods identified therein. The record does include sales for several years for the goods identified in the application.<sup>64</sup> These figures are designated confidential; suffice to say we agree with Opposer that the level of sales is relatively modest. Both parties have a social media presence on Facebook, Twitter, and Instagram which serves as a method of advertising their respective goods.<sup>65</sup> As noted above, the trade channels for all of Opposer's marks (and Opposer's registered mark) include the official MLB website at [www.mlbshop.com](http://www.mlbshop.com), the websites of MLB Clubs, in-stadium concessionaries, The Cubs Store, brick-and-mortar retail stores such as Dick's Sporting Goods, Target, and Bed Bath & Beyond, and online sport fan sites such as [Fanatics.com](http://Fanatics.com) and [FansEdge.com](http://FansEdge.com).<sup>66</sup> Applicant's trade channels are limited to its retail store located in Rockaway, Queens and its business-to-consumer website.<sup>67</sup>

Standing alone, the fact that both parties have a presence on the same social media sites does not constitute a sufficient level of evidence to evaluate the extent of consumer market exposure to each mark. *New Era*, 2020 USPQ2d 10596, at \*18. Given the lack of actual overlap of trade channels with Opposer's goods, the record

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<sup>64</sup> Kirk Decl., 53 TTABVUE (confidential).

<sup>65</sup> King Decl. ¶¶ 13, 15, and 16, 41 TTABVUE 8; Kirk Decl. ¶ 11, 52 TTABVUE 5.

<sup>66</sup> Nolan Decl. ¶ 7, 39 TTABVUE 8.

<sup>67</sup> Kirk Decl., ¶ 7, 52 TTABVUE 4.

fails to show appreciable use by Applicant of its mark in the same markets as those served by Opposer under its mark. *See Citigroup*, 94 USPQ2d at 1660. Accordingly, this factor is neutral.

## 6. Applicant's Intent

Lastly, we consider Applicant's intent in choosing the mark , and whether it reflects a bad-faith attempt to trade on Opposer's goodwill in its mark. *See, e.g., J & J Snack Foods v. McDonald's*, 18 USPQ2d at 1891 ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered[.]"); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) ("proof of intent to trade on another's goodwill" can provide "persuasive evidence of likelihood of confusion"). A party's bad faith in adopting a mark is relevant to the thirteenth *DuPont* factor, which includes "any other established fact probative of the effect of use." *Quicktrip W., Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at \*4 (Fed. Cir. 2021). Establishing bad faith requires a showing that the applicant intentionally sought to trade on the opposer's good will or reputation. *See Big Blue Prods. Inc. v. Int'l Business Machines Corp.*, 19 USPQ2d 1072, 1076 (TTAB 1991).

Opposer directs our attention to Applicant's discovery responses<sup>68</sup> and the testimony of Applicant's co-founder, Mr. Kirk as evidence of bad faith because Opposer was aware of the Chicago Cubs and its trademarks. In particular, Opposer

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<sup>68</sup> Opposer Notice of Reliance, Exs. B, F, 34 TTABVUE 129, 174 (confidential) (Applicant's response to Opposer's Interrogatory No. 16 and Responses to Opposer's Request for Admission Nos. 11-12).

points to Mr. Kirk’s statement that “as of the date on which The Crate selected its mark and as of the date The Crate first used the mark, I was personally aware of the Chicago Cubs, of the colors red, white, and blue, and the following marks belonging to Opposer:



An applicant’s prior knowledge of an opposer or its similar marks is not, in itself, sufficient to constitute bad intent. *See Quicktrip*, 2021 USPQ2d 35, at \*4; *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another’s mark or even an intent to copy. *See Quicktrip*, 2021 USPQ2d 35, at \*4 (citing *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009)). Mr. Kirk testified that Applicant selected the mark  because its trade name “Crate” commences with the letter C and because the design “is aesthetically pleasing,”<sup>70</sup> sentiments devoid of bad faith.

The record further shows that Applicant “did not conduct any focus groups, surveys or other market investigations before adopting its mark.”<sup>71</sup> However, Applicant’s failure to conduct a trademark search or survey for potentially confusing

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<sup>69</sup> Kirk Decl. ¶ 19, 52 TTABVUE 7.

<sup>70</sup> Kirk Decl. ¶ 16, 52 TTABVUE 6.

<sup>71</sup> Kirk Decl. ¶ 16, 52 TTABVUE 6.

marks does not support an inference of bad faith. Even if a comprehensive search for variations of trademarks comprised of the letter C would have disclosed Opposer's registered and common law marks, mere awareness would not establish bad faith. *See Quicktrip*, 2021 USPQ2d 35, at \*4.

However, we do find relevant Opposer's evidence obtained from Applicant's Instagram account that Applicant advertised and sold apparel items targeted to sports fans, including baseball hats and sweatshirts, prominently displaying Opposer's "Walking Bear Cub" mark as depicted in Opposer's pleaded Registration No. 1916572 noted above. Opposer argues that Applicant's use of Opposer's Walking Bear Cub Mark prior to adopting Applicant's  mark demonstrates a lack of good faith. By way of illustration, below are examples of the Walking Bear Cub mark used in connection with Applicant's baseball hats and sweatshirts in 2015:



Mr. Kirk in his testimony directly addresses Opposer’s concern in the following manner:

[I]n or about 2015, The Crate designed and sold a hat that included a stylized version of its name (“Crate”) using the first letters of various baseball teams, including the Cubs. This item was the result of a limited-edition series of hats made in collaboration with a third-party brand (SUCKAFREE). However, the hat did not include The Crate’s stylized “C” mark that is the subject of this proceeding. There are no instances of The Crate’s subject

mark being used by The Crate in connection with indicia associated with Major League Baseball or The Chicago Cubs.<sup>72</sup>

Applicant further maintains that “[w]hat the hat and sweatshirt [appearing in the Instagram printouts] did include were logos for other sports teams, thereby refuting any argument that The Crate was attempting to appropriate the Cubs’ goodwill during their 2015 run up to the post-season.”<sup>73</sup>

Although the Walking Bear Cub Mark is not identical to Opposer’s C mark that we are using as our basis for comparison, it does incorporate the same square edged shaped letter C. Applicant’s co-founder testified that the following year, he conceived of Applicant’s  mark and had a third-party graphic designer implement his vision.<sup>74</sup> He further testified that Applicant commenced use of its mark on February 28, 2016 in connection with the majority of goods identified in the application.<sup>75</sup>

Despite the timing of the above events and striking visual similarities of the marks, the record does not support a finding of bad faith on the part of Applicant in creating, designing, and adopting its applied-for mark. *See Quicktrip*, 2021 USPQ2d 35, at \*4 (citing *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) (“[T]he ‘only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.’” (internal citation omitted))). The testimony Applicant presented makes clear that

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<sup>72</sup> King Decl. ¶ 40, 52 TTABVUE 11.

<sup>73</sup> Applicant’s Brief, p. 19, 64 TTABVUE 26.

<sup>74</sup> King Decl. ¶ 15, 52 TTABVUE 6.

<sup>75</sup> King Decl. ¶ 17, 52 TTABVUE 6.

Applicant's use was merely part of a limited edition arrangement with a third-party. Accordingly, this factor is neutral.

### **7. Balancing the Factors**

Opposer's C mark for "clothing, namely, caps, hats, headwear, headbands, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, sleepwear, jackets, cloth bibs, infantwear, footwear, socks" in International Class 25 is conceptually strong, and according to the record before us, has not been weakened by third-party use or registrations. Overall, it is similar in sound, appearance, connotation and commercial impression when compared with Applicant's  mark. The in-part identity of Applicant's and Opposer's goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of a finding of likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. Prospective consumers are likely to exercise only ordinary care. Weighing these factors, we find confusion likely. The remaining factors discussed above are neutral. In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *DuPont* factors, as well as all of the parties' arguments with respect thereto. We also keep in mind that "[w]hen the goods are identical, the appearance of a mark of similar sound, appearance, or connotation is more likely to cause confusion than if the goods are significantly different." *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *see also New Era*, 2020 USPQ2d 10596, at \*14.

Accordingly, we find that Opposer has proved its entitlement to a statutory cause of action, priority, and likelihood of confusion by a preponderance of the evidence.

**Decision:** Opposer's Section 2(d) claim is sustained. In view thereof, we need not reach Opposer's Section 2(a) and dilution by blurring claims. *See Weider Publ'ns*, 109 USPQ2d at 1361 (Board, after sustaining opposer's Section 2(d) claim, did not consider opposer's dilution by blurring claim). *See also Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (Board has "discretion to decide only those claims necessary to enter judgment and dispose of the case" as its "determination of registrability does not require, in every instance, decision on every pleaded claim.").